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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|----------------------------|-------------|----------------------|---------------------|-------------------|
| 10/048,086 | 03/05/2002 | Jorg Tillack | Mo-6924/LeA 33,697 | 1660 |
| 157 | 7590 | 02/17/2005 | | EXAMINER |
| BAYER MATERIAL SCIENCE LLC | | | | SELLERS, ROBERT E |
| 100 BAYER ROAD | | | | |
| PITTSBURGH, PA 15205 | | | ART UNIT | PAPER NUMBER |
| | | | 1712 | |

DATE MAILED: 02/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) |
|------------------------------|------------------------|---------------------|
| | 10/048,086 | TILLACK ET AL |
| Examiner | Art Unit | |
| Robert EL Sellers | 1712 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 20 December 2004.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 13-32 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) Claim(s) _____ is/are allowed.
6) Claim(s) 13-32 is/are rejected.
7) Claim(s) _____ is/are objected to.
8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ .

5) Notice of Informal Patent Application (PTO-152)

6) Other: ____ .

1. This is responsive to the Request for Continued Examination and amendment filed December 20, 2004.

2. 35 U.S.C. 363, PCT Article 11(3) and MPEP § 1893.03(b) establishes the filing date of an application filed under 37 CFR 371 as the international filing date of the international application. The instant application filed March 5, 2002 has been filed under 37 CFR 371 and relates to international application no. PCT/EP00/06801 having a filing date of July 17, 2000. Therefore, the effective filing date of the instant application is July 17, 2000. Schmalsteig et al. Patent No. 6,060,574 issued May 9, 2000 qualifies as a reference under 35 U.S.C. 102(e)/103(a) based on the effective filing date of the application.

3. Schmalsteig et al. is assigned to Bayer Aktiengesellschaft which is the same as that of the instant application. Applicant states on page 6 of the Remarks section of the amendment that “[t]he present application, Ser. No. 10/048,086 and U.S. Patent No. 6,060,574 to Schmalstieg et al. were, at the time the invention of the present application was made, owned by Bayer Aktiengesellschaft.” This statement follows the format presented in MPEP § 706.02(I)(2), II. Evidence Required to Establish Common Ownership. Accordingly, Schmalsteig et al. is no longer applicable as a reference under 35 U.S.C. 102(e)/103(a).

4. Since Schmeilstieg et al. is no longer available as a reference under 35 U.S.C. 102(e)/103(a), the 35 U.S.C. 103(a) rejection over Schmalstieg et al. in view of Groegler et al. is rescinded. The 35 U.S.C. 103(a) rejection over Lauman Patent No. 4,753,826 and Xiao et al. Patent No. 6,153,709 in view of (Schmalstieg et al. and Boutilier et al. Patent No. 4,908,408) and (Japanese Patent No. 50-117771 and Tarbutton et al. Patent No. 6,486,256) relies upon Schmalstieg et al. and Boutilier et al. to teach the claimed blocking agent for the polyisocyanate of a phenolic OH groups-containing hydrocarbon resin (non-Final rejection mailed January 7, 2004, page 3, last paragraph).

5. Schmalstieg et al. has been eliminated as a 35 U.S.C. 102(e)/103(a) reference for the reasons espoused in paragraph 3 hereinabove. Boutilier et al. discloses the use of a terpene-phenolic resin as a polyisocyanate blocking agent (col. 2, lines 46-52). The claims have been limited to a phenolic OH groups-containing hydrocarbon resin blocking agent obtained by the copolymerization of phenol and certain species of unsaturated hydrocarbons (as supported by page 8, lines 6-12 of the specification) other than terpene. There is no motivation to block the polyisocyanate of Lauman and Xiao et al. with the claimed phenolic OH groups-containing hydrocarbon resin derived from the defined species of unsaturated hydrocarbon monomers.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. The basis for the hydroxyl group content of the phenolic OH groups-containing hydrocarbon resin as "(calculated as OH, molecular weight 17)" in claim 13, line 7 and claim 14, lines 7-8 as well as page 8, line 16 of the specification is unclear since it cannot be ascertained to what the molecular weight of 17 refers, and how the OH percentage is derived therefrom.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 13-32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6,060,574 in view of Japanese Patent No. 50-117771 and Tarbutton et al. Patent No. 6,486,256.

7. The claims of the patent denote a composition comprising A) an organic polyisocyanate having a molecular weight, excluding the blocking agent, of from 168 to 25,000 wherein the isocyanate groups are reversibly blocked with a hydrocarbon resin containing phenolic OH groups, B) an organic polyamine with at least two primary amino groups and C) a compound containing oxirane groups.

8. The phenolic OH groups-containing hydrocarbon resin embraces the copolymerization product of phenol with the claimed species of unsaturated hydrocarbon monomers according to column 4, lines 9-18. MPEP § 804 (as ruled in *In re Vogel*, 164 USPQ 619, CCPA, 1970) states:

“[T]hose portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in the application defines an obvious variation of an invention claimed in the patent.”

9. The claimed blocking of at least 95 mole% of the NCO groups is not recited. It would have been obvious to completely block 100 mole% of the isocyanate groups of the polyisocyanate of the patent in order to prevent the premature reaction of the polyisocyanate with the polyamine and/or the oxirane groups-containing compound.

10. The claimed 2,3-dimethyl-3,4,5,6-tetrahydropyrimidine catalyst is not recited. The Japanese patent sets forth the reaction of an epoxy resin and a diisocyanate in the presence of 1,2-dimethyl-1,4,5,6-tetrahydropyrimidine (equivalent to the claimed compound according to Chemical abstracts registry no. 4271-96-9, attached to the CAPLUS abstract of the Japanese patent).

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Tarbutton et al. (col. 9, lines 9-20) recognizes the copolymerization of an epoxy resin (col. 8, line 2) and an amine in the presence of 1,2-dimethyl-1,4,5,6-tetrahydropyrimidine.

11. It would have been obvious to use the 2,3-dimethyl-3,4,5,6-tetrahydropyrimidine of the Japanese patent and Tarbutton et al. as a catalyst in the composition of U.S. Patent No. 6,060,574 in order to optimize the reaction rate and/or temperature and to improve the load durability and impact resistance (Tarbutton et al., col. 9, lines 11-15).

Any inquiry concerning this communication or earlier communications should be directed to Robert E. L. Sellers whose telephone number is (571) 272-1093. The examiner can normally be reached on Monday to Friday from 9:30 AM to 6:00 PM.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

rs 2/15/05



ROBERT E.L. SELLERS
PRIMARY EXAMINER